UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,896	12/21/2001	Jorge Pereyra	241280-201	5099

			EXAMINER
24229	7590	03/31/2005	GREENE, DANIEL L

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ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/029,896	PEREYRA, JORGE
	Examiner	Art Unit
	Daniel L. Greene	3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>21 December 2001</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-10</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-10</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>21 December 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/2001</u>.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or

any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and

requirements of this title.

Claims 1, 5, 7, and 8 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter. These claims are hybrid claims

and do not specifically identify what statutory class the Applicant intends them to be in.

The Examiner will treat the aforedesignated claims as systems claims for examination.

Claim Interpretation

Claims directed to an apparatus must be distinguished from the prior art in terms

of structure rather than function, *In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531*

(CCPA 1959). A claim containing a " recitation with respect to the manner in which a

claimed apparatus is intended to be employed does not differentiate the claimed

apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural

limitations of the claim. *Ex parte Masham, 2 USPQ2d 1647 (Bd Pat. App. & Inter. 1987).*

Thus the structural limitations of claims 1, 5, 7, and 8, *including communications*

network and delivery system comprising the structural elements of a network, a memory

and a processor are disclosed in the prior art *as described below. Also, as described*

above, the functional limitations in claim 1, 5, 7, and 8 *do not distinguish the claimed*

apparatus from the prior art.

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shub et al. U.S. Patent 6,807,530 [Shub], and further in view of Rosen U.S. Patent 5,557,518 [Rosen].

3.

4.   As per claim 1:

5.   Shub discloses:

a switching communication device for switching communications between entities attached to said Network; Col. 1, lines 57-59.

a Merchant server (Merchant) in communication with said Network, said Merchant including an interface for selling at least one item, including but not limited to products and/or services (Products); said Merchant having at least one payment method that can be *used by a User for* requesting an electronic purchase; Col. 6, lines 43-67.

a Client device (Client) in communication with said Network, *said Client*
including a browser software and output device for reviewing said one item for sale, an
input device used by the User for initiating a purchase transaction to purchase said one
item for sale; Col. 4, lines 25-40.

Shub discloses the claimed invention except for a Solution's Server (Agent)
in. communication with said Network, said Agent being an intermediary between the
Client and the Merchant and being the Client's Agent before the Merchant and a
Delivery Agent, said Agent comprising a Solution's Accounts Manager system, said
Agent also comprising a Content Manager system that manages the content embedded
in electronic messages, said Agent also having a secure and fraud inhibitor method and
system that submits the electronic purchase to the Merchant on behalf of the User and
processes payments to said Merchant, said Agent also having a system *and* method for
delivering said purchase to the User anonymously. Rosen teaches that it is known in
the art to provide a Solution's Server (Agent) in. communication with said Network, said
Agent being an intermediary between the Client and the Merchant and being the Client's
Agent before the Merchant and a Delivery Agent, said Agent comprising a Solution's
Accounts Manager system, said Agent also comprising a Content Manager system that
manages the content embedded in electronic messages, said Agent also having a
secure and fraud inhibitor method and system that submits the electronic purchase to
the Merchant on behalf of the User and processes payments to said Merchant, said
Agent also having a system *and* method for delivering said purchase to the User
anonymously. Fig. 4 A-D, Col. 8-9, lines 55-67 and 1-67 respectively.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the Anonymous Customer Protocol of Shub with the Trusted Agent system of Rosen, in order to enhance and simplify the actions required by the customer in Shub's Anonymous Customer Protocol system thus providing incentive for other customers to use the system.

Shub further discloses:

a Payment Processor used by said Merchant to request payments authorization for said electronic *purchase, said Payment Processor having a server (Payment Processor's Server) in* communication with said Merchant through. said Network or other communication method, including but not limited to Internet, value added networks, point to point telephone lines, fax system and telephone systems, said Payment Processor's Surer acting as the Payment Processor for said Merchant for said electronic purchase; Col. 4, lines 10-25.

an Issuer that issues payment methods to be used by the Agent for submitting the electronic purchase to the Merchant, said Issuer having a server (Issuer's server) in communication with said Agent and said Payment Processor's Server through. the Network or other communication method, including but not limited to Internet, value added networks, point to point telephone lines, fax system and telephone systems, said Iss^uer's acting as the payment authorization gateway between the Payment Processor and the .Agent; Col. 4, lines 10-60. and

a Delivery Agent in communication with said Agent through said Network or other communication method, including but not limited to Internet, value added networks,

point to point. telephone lines, fax system and telephone systems, said Delivery Agent

being arranged to deliver said electronic purchase to the User based on the delivery

instructions previously notified by the Agent. Col. 5, lines 23-47.

As per claim 2:

Shub further discloses:

a selling interface: Col. 4, lines 25-35.

at least one payment method that may be used by the buyer for paying for the

electronic purchase; Col. 4, lines 10-35.

a labeling process that creates and assigns the Order's Unique Identifier to said

order; Col. 6, lines 43-67.

a delivery method that delivers said order to the buyer; said delivery method

being a transportation method for delivering physical orders or an electronic

transmission method for delivering electronic orders; Col. 5, lines 23-67.

a Purchase Confirmation Message process that sends a message to the buyer

notifying the *delivery of said order, the Order Unique Identifier and* the Order Details

comprising at least one of transaction amount, item, billing address, shipping address

and date. Col. 4, lines 10-67.

Shub discloses the claimed invention except for a packing process that

packs the items of said electronic purchase in an order. It would have been obvious to

one having ordinary skill in the art at the time of the invention was made to have a

packing process that packs the items of said electronic purchase in an order since it is

known in the art that that to deliver an item to a customer there must be a packing process that packs the items of said electronic purchase in an orders.

Further, Shub discloses the claimed invention except for the specific details in the Purchase Confirmation Message. Rosen teaches that it is known in the art to provide a Purchase Confirmation Message process that sends a message to the buyer notifying the *delivery of said order, the Order Unique Identifier and* the Order Details comprising at least one of transaction amount, item, billing address, shipping address and date. Col. 6, lines 42-67. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the payment agency of Shub with the Purchase Confirmation Message process that sends a message to the buyer notifying the *delivery of said order, the Order Unique Identifier and* the Order Details comprising at least one of transaction amount, item, billing address, shipping address and date of Rosen because it would have been obvious to one having ordinary skill in the art at the time of the invention was made to have a Purchase Confirmation Message process that sends a message to the buyer notifying the *delivery of said order, the Order Unique Identifier and* the Order Details comprising at least one of transaction amount, item, billing address, shipping address and date. since it is known in the art that confirmation of an order is old and well known.

As per claim 3:

Shub further discloses:

an Account Registration process being arranged to compute the necessary

information required to submit an electronic purchase to said Merchant (Solution's

name, Solution's password, Solution's email, Solution's shipping address, Solution's

billing address and Solution's payment method, among others), said process also being

arranged to create or modify a Solution's Account on said Merchant with all the

necessary information required to submit the electronic purchase to said Merchant, said

process also being arranged to delete a Solution's Account on said Merchant; Col. 3-4,

lines 1-67.

a Link User to Solution's Account process that associates a User of the Solution

with a Solution's Account wherein said association may be in a one (User) to one

(Solution's Account) basis or may be in a many (Users) to one (Solution's Account)

basis. Col. 3-4, lines 1-67

Shub discloses the claimed invention except for a Replace a Payment Method

process being arranged to replace a payment method for a given Solution's Account

and given Merchant. Rosen teaches that it is known in the art to provide a Replace a

Payment Method process being arranged to replace a payment method for a given

Solution's Account and given Merchant. Col. 28, section titled Disputes, Col. 40-41,

sections titled Commit (Module), Abort (Module).

It would have been obvious to one having ordinary skill in the art at the time the

invention was made to provide the commerce system of Shub with the Replace a

Payment Method process being arranged to replace a payment method for a given

Solution's Account and given Merchant Rosen, in order to either provide a way to

resolve a conflict within the transaction or provide an alternative payment option to

complete the transaction.

As per claim 4:

Shub discloses the claimed invention, as discussed above, except for the steps

of a Builder process that constructs an electronic message based on information

previously received and/or computed by the Builder process;

a Modifier process that based on predefined rules modifies and/or substitutes all

or part of a specific embedded content, said Modifier process also to communicate said

specific embedded content to the Builder process;

a Parser process that, based on predefined rules, searches for, specific content

embedded in said electronic *message* and extracts said specific content, said process

also being arranged to communicate said specific content to *the* Modifier and/or Builder

processes;

a Sender process that sends electronic message over the Network.

However, Shub does teach about the use of protocols for the exchange of information.

Col. 6, lines 15-20.. It would have been an obvious to modify the teachings of Shub, to

provide the steps of a Builder process that constructs an electronic message based on

information previously received and/or computed by the Builder process;

a Modifier process that based on predefined rules modifies and/or substitutes all
or part of a specific embedded content, said Modifier process also to communicate said
specific embedded content to the Builder process;

a Parser process that, based on predefined rules, searches for, specific content
embedded in said electronic *message* and extracts said specific content, said process
also being arranged to communicate said specific content to *the* Modifier and/or Builder
processes;

a Sender process that sends electronic message over the Network.

Since the applicant has not disclosed that a Builder process that constructs an
electronic message based on information previously received and/or computed by the
Builder process;

a Modifier process that based on predefined rules modifies and/or substitutes all
or part of a specific embedded content, said Modifier process also to communicate said
specific embedded content to the Builder process;

a Parser process that, based on predefined rules, searches for, specific content
embedded in said electronic *message* and extracts said specific content, said process
also being arranged to communicate said specific content to *the* Modifier and/or Builder
processes;

a Sender process that sends electronic message over the Network, solves any stated
problem in a new or unexpected way or is for any particular purpose which is unobvious
to one of ordinary skill and it appears that the claimed feature does not distinguish the

invention over similar features in the prior art since, the teachings of Shub will perform the invention as claimed by the applicant with any means, method, or product to provide a Builder process that constructs an electronic message based on information previously received and/or computed by the Builder process;

a Modifier process that based on predefined rules modifies and/or substitutes all or part of a specific embedded content, said Modifier process also to communicate said specific embedded content to the Builder process;

a Parser process that, based on predefined rules, searches for, specific content embedded in said electronic *message* and extracts said specific content, said process also being arranged to communicate said specific content to *the* Modifier and/or Builder processes;

a Sender process that sends electronic message over the Network.

As per claim 5:

Shub further discloses:

under the control of an Agent, a Submit Purchase to Merchant and Make Payments to Merchant process that -splits the User's electronic purchase transaction in two processes while managing those processes independently: (i) the Purchase on behalf of the User process and (ii) the Payment Authorization to Merchant process, said Payment Authorization process being arranged to receive payments authorization requests for purchase transactions and authorize or deny said payment authorization requests, said Payment Authorization process being arranged to validate said

purchases transaction prior to authorize or deny said payment authorization requests, said purchase validation being arranged to be processed by the Issuer (Offline Payment Authorization) or by the Agent (Online Payment Authorization);Col. 4, lines 25-67.

a Create Delivery Instructions process being arranged to compute all the necessary Order's Delivery Instructions needed by the Delivery Agent to repackage an order and to deliver it to the User, said process also being arranged to communicate said Delivery Instructions to the Send Delivery Instructions to Delivery Agent process; Col. 5, lines 23-45. and

a Send Delivery Instructions to Delivery Agent process that sends the Order's Unique Identifier, Order's Details and Order's Deliver Instructions for said order to the Delivery .Agent, said process being arranged to be based on the Content Manager system for extracting the Order's Unique Identifier and Order's Details from the Merchant's electronic purchase confirmation message, Col. 7, lines 1-21.

As per claim 6:

Shub further discloses:

a User's Payment process that identifies the User's electronic purchase and manages the User's payment prior to submitting said electronic purchase to Merchant, said User's Payment process also being arranged to compute and add to the User's payment amount other charges comprising one of service fees, commissions and shipping and handling prior to requesting the User's payment, said User's Payment process also being arranged to offer to the User different payment methods in

combination with payments and/or financial plans either supported only by the Solution (proprietary) or supported by the Solution in partnership with other institutions, said User's Payment process also being to generate a User's payment authorization code, said User's Payment process also being arranged to communicate said User's payment authorization code to the 5 Purchase process; Col. 4, lines 10-25, Col, 6, lines 8-16.

a Data Required by Merchant for Purchase Completion process that completes the Purchase Data that it is required by the Merchant to accept said electronic purchase, said data being arranged to be computed by the Data Required by Merchant for Purchase Completion process and/or retrieved from a Solution's Account for said Merchant and said User, said Data Required by Merchant for Purchase Completion process also being arranged to communicate said data to the Submit Purchase process; Col. 6, lines 8-67. and

a Submit Purchase process that based on the user's payment authorization code, submits said electronic purchase to the Merchant using said Purchase Data and said Solution's Account for said Merchant, said Submit Purchase process also being arranged to store the electronic purchase information details in a database and mark said electronic purchase. Col. 6, lines 1-67.

As per claim 7:

Shub further discloses:

receiving the purchase transaction (either from electronic or traditional retailers) from the Issuer's Server including a transaction code, transaction details and payment method; Col. 4-5, lines 10-67 and 1-20 respectively.

validating the purchase transaction, said validation being arranged to use a comparator to compare the data related to the purchase received from the Issuer's Server with those the electronic purchase stored in the Agent; Col. 4-5, lines 10-67 and 1-20 respectively.

generating an authorization code based on the purchase validation for said purchase and transmitting said authorization code and transaction code to said Issuer's server; and marking an electronic purchase based on the authorization code. Col. 4-5, lines 10-67 and 1-20 respectively.

As per claim 8:

Shub discloses the claimed invention except for receiving the payment authorization instructions from the Agent for the electronic purchase submitted by said Agent, the payment authorization instructions comprising a transaction code, transaction details and payment method;

receiving the authorization request from the Payment Processor's Server for a purchase transaction. (either from electronic or traditional retailers) including a transaction code, transaction details and payment method;

validating the purchase transaction, said validation being arranged to use a

comparator to compare the data related to the purchase transaction received from the

Payment Processor's Server with the data related to the electronic purchase received

from the Agent;

generating an authorization code based on the purchase validation for said

electronic purchase and transmitting said authorization code and transaction code to

said. Agent; said Agent marking said electronic purchase based on the authorization

code; and

transmitting said authorization code and transaction code to said Payment

Processor's Server, whereby said Merchant is authorized to release said item of

merchandise to the buyer associated with said purchase transaction; and

marking the electronic purchase based on the authorization code.

Rosen teaches that it is known in the art to provide receiving the payment

authorization instructions from the Agent for the electronic purchase submitted by said

Agent, the payment authorization instructions comprising a transaction code,

transaction details and payment method;

receiving the authorization request from the Payment Processor's Server for a

purchase *transaction. (either from* electronic or traditional retailers) including a

transaction *code,* transaction details and payment method;

validating the purchase transaction, said validation being arranged to use a

comparator to compare the data related to the purchase transaction received from the

Payment Processor's Server with the data related to the electronic purchase received

from the Agent;

generating an authorization code based on the purchase validation for said

electronic purchase and transmitting said authorization code and transaction code to

said. Agent; said Agent marking said electronic purchase based on the authorization

code; and

transmitting said authorization code and transaction code to said Payment

Processor's Server, whereby said Merchant is authorized to release said item of

merchandise to the buyer associated with said purchase transaction; and

marking the electronic purchase based on the authorization code.

Fig. 4 A-D, Col. 8-9, lines 55-67 and 1-67 respectively.

It would have been obvious to one having ordinary skill in the art at the time

the invention was made to provide the Anonymous Customer Protocol of Shub with the

Trusted Agent system of Rosen, in order to enhance and simplify the actions required

by the customer in Shub's Anonymous Customer Protocol system thus providing

incentive for other customers to use the system.

As per claim 9:

Shub further discloses:

receiving from. the Agent the Order's Unique Identifier and the Order's Delivery

instructions needed by the Delivery Agent to repackage said order and to deliver it to

the User; Fig. 3-4, Col. 6-7, lines 40-67 and 1-20 respectively.

receiving the order labeled with the Order's Unique Identifier from the Merchant;

validating the Order's Unique Identifier, said validation being arranged to use a

comparator to compare the Order's Unique Identifier received from the Agent with the

Order's Unique Identifier in the order's label; Fig. 3-4, Col. 6-7, lines 40-67 and 1-20

respectively.

a method for repacking and/or consolidating physical orders in accordance with

the Order's Delivery Instructions received from the Agent; Fig. 3-4, Col. 6-7, lines 40-67

and 1-20 respectively.

a method for forwarding electronic orders in accordance with the Order's Delivery

Instructions received from the Agent; Fig. 3-4, Col. 6-7, lines 40-67 and 1-20

respectively.   and

delivering the order to the User and sending a message to the Agent. Fig. 3-4,

Col. 6-7, lines 40-67 and 1-20 respectively.

As per claim 10:

Shub further discloses:

a method for tracking the order through the Network. Fig. 3-4, Col. 6-7, lines 40-

67 and 1-20 respectively.

Examiner's Note: Examiner has cited particular columns and line numbers in the

references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are

applied to the specific limitations within the individual claim, other passages and figures

may apply as well. It is respectfully requested from the applicant, in preparing the

responses, to fully consider the references in entirety as potentially teaching all or part

of the claimed invention, as well as the context of the passage as taught by the prior art

or disclosed by the examiner.

Conclusion

6.　　　The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. Tozzoli et al. U.S. Patent 6,151,588 FULL SERVICE TRADE

SYSTEM.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Daniel L. Greene whose telephone number is 703-306-

5539. The examiner can normally be reached on M-Thur. 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

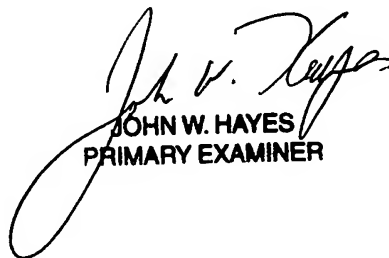supervisor, James P. Trammell can be reached on 703-305-9768. The fax phone

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel L. Greene
Examiner
Art Unit 3621

3/15/2005

JOHN W. HAYES
PRIMARY EXAMINER